

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|--------------------------------|---|---------------------------|
| In re Patent Application of |) | MAIL STOP PETITION |
| Yi-Qun Li et al. |) | Group Art Unit: 1755 |
| Application No.: 10/829,590 |) | Examiner: Carol M. KOSLOW |
| Filed: April 21, 2004 |) | Confirmation No.: 6712 |
| For: MAGNETIC DOPED PEROVSKITE |) | |
| OXIDES |) | |
| |) | |
| |) | |
| |) | |

Request for Reconsideration of Decision on Petition

Mail Stop: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the dismissal of their Petition dated April 27, 2006 and filed on May 4, 2006 based on the following facts and in view of the attached documents.

1. Applicants (inventors) filed the subject application in pro per on April 21, 2004 with each inventor signing a separate document listing their employment address as their address for correspondence. No assignment is believed to have been filed in the U.S. Patent and Trademark Office (USPTO). (EXHIBIT A)

2. A Notice to file Missing Parts was issued by the USPTO dated July 9, 2004 requiring submission of a substitute specification, replacement drawings, an abstract and additional filing fees. (EXHIBIT B)

3. On or about September 15, 2004, the Applicants engaged the law firm of Burns Doane Swecker & Mathis LLP ("Burns Doane") to prepare and file a response to the Notice to file Missing Parts.

4. On or about November 9, 2004, a complete response to the Notice to file Missing Parts was filed by Registered Patent Agent Steven F. Powell, an employee of Burns Doane. The response included a substitute Declaration, Power of Attorney and Petition including the following statement: By implication, this document clearly notified the USPTO of a change of address for correspondence in transactions relating to the application. The response also included a check cosigned by the undersigned, a Burns Doane partner, covering the required filing fees. (EXHIBITS C & D)

5. On information and belief, Patent Agent Powell believed that since substantial amendments were being made to the application, it would be prudent to file a new Declaration along with the new Power of Attorney and believed that the firm's standard combined form (Exhibit C above) was appropriate to use for that purpose.

6. That during the early summer of 2005, the Applicants' place of business, and thus their mailing address changed to a new address, namely; Intematix Inc., 46410 Fremont Blvd., Fremont, CA 94538

7. That on July 6, 2005, an Office Action was issued addressed to the Applicants at their former address, and not to the Applicants' attorneys associated with the Customer Number 21839. (EXHIBIT E)

8. That on information and belief, the Office Action of July 6, 2005 never reached the Applicants at their new address nor was it received by Applicants' attorneys.

9. That in May of 2005, Burns Doane was acquired by the law firm of Buchanan Ingersoll PC (now Buchanan Ingersoll & Rooney) and subsequently, the Customer Number 41790 was changed to 21839, (hence the reason for the possible confusion indicated at the top of page 2 of the Decision on Applicants' original Petition), and a formal transfer of Burns Doane matters to the new customer number was effected. (EXHIBIT F)

10. That on February 13, 2006 a Notice of Abandonment was issued addressed to the Applicants at their former address and not to the Applicants attorneys associated with the Customer Numbers 21839 or 41790.

11. That neither Applicants nor their attorneys received the Notice of Abandonment, nor had any knowledge of the fact that the Office Action and Notice of Abandonment had been issued by the USPTO.

12. That on April 12, 2006, having received no communications from the USPTO regarding the application subsequent to the filing of the response to the Notice to File Missing Parts, Krista Chaffin-Penny, secretary to the undersigned, called the USPTO to check on the status of the application and was informed by the Examiner that the application had been abandoned in February 2006, and that the Notice of Abandonment had been sent to Applicants' old address instead of to Applicants' attorneys. The Examiner informed Ms Chaffin-Penny that she would have to file a "Letter" stating the facts and requesting withdrawal of the holding of

abandonment. At her request, the Examiner forwarded a copy of the Notice of Abandonment to her. (EXHIBITS G and H)

13. That upon receipt of the Notice of Abandonment, and believing that the attorneys, acting on behalf of the Applicants, had properly notified the USPTO of the new address for correspondence, namely; that associated with the Burns Doane customer number stated in the Declaration, Power of Attorney and Petition identified above in paragraph 4, it appeared that the reason for the abandonment was in fact the failure of the USPTO to send the Office Action to the correct address, and that, as suggested by the Examiner, the matter could be corrected by Applicants' Letter dated April 27, 2006.

14. That neither the Applicants nor their attorneys ever intended to abandon the subject application and that the abandonment was unintentional.

15. That the Applicants have now submitted a complete response to the Second Office Action along with a Terminal Disclaimer.


Applicants respectfully submit that the application is now in condition for allowance and request that it be revived and passed to issue.

Respectfully submitted,

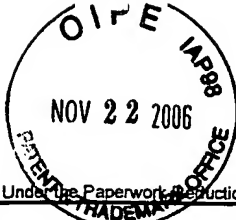
BUCHANAN INGERSOLL & ROONEY LLP

Date: November 20, 2006

By:


Claude A.S. Hamrick
Registration No. 22586

P.O. Box 1404
Alexandria, VA 22313-1404
650 622 2300



UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.

First Inventor

Yi-Qun Li

Title

Magnetic Doped Perovskite Oxides

Express Mail Label No.

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO:

Mail Stop Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)
(Submit an original and a duplicate for fee processing)
2. ☒ Applicant claims small entity status.
See 37 CFR 1.27.
3. ☒ Specification [Total Pages 8]
(preferred arrangement set forth below)
- Descriptive title of the invention
- Cross Reference to Related Applications
- Statement Regarding Fed sponsored R & D
- Reference to sequence listing, a table,
or a computer program listing appendix
- Background of the Invention
- Brief Summary of the Invention
- Brief Description of the Drawings (if filed)
- Detailed Description
- Claim(s)
- Abstract of the Disclosure
4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 10]
5. Oath or Declaration [Total Sheets _____]
a. ☒ Newly executed (original or copy)
b. ☐ Copy from a prior application (37 CFR 1.63(d))
(for continuation/divisional with Box 18 completed)
i. ☐ **DELETION OF INVENTOR(S)**
Signed statement attached deleting inventor(s)
name in the prior application, see 37 CFR
1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76

7. ☐ CD-ROM or CD-R in duplicate, large table or
Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission
(if applicable, all necessary)
a. ☐ Computer Readable Form (CRF)
b. Specification Sequence Listing on:
i. ☐ CD-ROM or CD-R (2 copies); or
ii. ☐ Paper
c. ☐ Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(b) Statement [Power of Attorney]
(when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure [Copies of IDS Citations]
Statement (IDS)/PTO-1449
13. ☐ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s)
(if foreign priority is claimed)
16. ☒ Nonpublication Request under 35 U.S.C. 122
(b)(2)(B)(i). Applicant must attach form PTO/SB/35
or its equivalent.
17. ☐ Other:

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in the first sentence of the specification following the title, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☐ Divisional ☐ Continuation-in-part (CIP) of prior application No.:

Prior application information:

Examiner:

Art Unit:

For CONTINUATION OF DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

19. CORRESPONDENCE ADDRESS

☐ Customer Number:

OR ☒ Correspondence address below

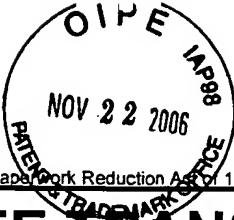
| | | | | | |
|---------|-----------------------|-----------|--------------|----------|--------------|
| Name | Intematix Corporation | | | | |
| Address | 351 Rheem Blvd | | | | |
| City | Moraga | State | CA | Zip Code | 94556 |
| Country | USA | Telephone | 925-631-9005 | Fax | 925-631-7892 |

| | | | |
|-------------------|-----------|-----------------------------------|---------|
| Name (Print/Type) | Yi-Qun Li | Registration No. (Attorney/Agent) | |
| Signature | | Date | 4/21/04 |

This collection of information is required by 37 CFR 1.53(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Exhibit A



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO/SB/17 (08-03)
Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 375

Complete if Known

| | |
|----------------------|------------------------|
| Application Number | New Patent Application |
| Filing Date | Herewith |
| First Named Inventor | Yi-Qun Li |
| Examiner Name | |
| Art Unit | |
| Attorney Docket No. | |

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number: 135490520076
Deposit Account Name: Intematix Corporation

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) during the pendency of this application

☒ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description | Fee Paid |
|----------------------------|----------------------------|------------------------|-----------|
| 1001 750 | 2001 375 | Utility filing fee | 375 |
| 1002 330 | 2002 165 | Design filing fee | |
| 1003 520 | 2003 260 | Plant filing fee | |
| 1004 750 | 2004 375 | Reissue filing fee | |
| 1005 160 | 2005 80 | Provisional filing fee | |
| SUBTOTAL (1) | | | (\$) 375 |

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims: 18
Independent Claims: 0
Multiple Dependent: 0

Extra Claims Fee from below Fee Paid

20** = 0 X = 0
- 3** = 0 X = 0

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description |
|----------------------------|----------------------------|--|
| 1202 18 | 2202 9 | Claims in excess of 20 |
| 1201 84 | 2201 42 | Independent claims in excess of 3 |
| 1203 280 | 2203 140 | Multiple dependent claim, if not paid |
| 1204 84 | 2204 42 | ** Reissue independent claims over original patent |
| 1205 18 | 2205 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$) 0

**or number previously paid, if greater, For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

| Fee Code (\$) | Fee Code (\$) | Fee Description | Fee Paid |
|---------------|---------------|--|----------|
| 1051 130 | 2051 65 | Surcharge - late filing fee or oath | |
| 1052 50 | 2052 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 130 | 1053 130 | Non-English specification | |
| 1812 2,520 | 1812 2,520 | For filing a request for ex parte reexamination | |
| 1804 920* | 1804 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 1,840* | 1805 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 110 | 2251 55 | Extension for reply within first month | |
| 1252 410 | 2252 205 | Extension for reply within second month | |
| 1253 930 | 2253 465 | Extension for reply within third month | |
| 1254 1,450 | 2254 725 | Extension for reply within fourth month | |
| 1255 1,970 | 2255 985 | Extension for reply within fifth month | |
| 1401 320 | 2401 160 | Notice of Appeal | |
| 1402 320 | 2402 160 | Filing a brief in support of an appeal | |
| 1403 280 | 2403 140 | Request for oral hearing | |
| 1451 1,510 | 1451 1,510 | Petition to institute a public use proceeding | |
| 1452 110 | 2452 55 | Petition to revive - unavoidable | |
| 1453 1,300 | 2453 650 | Petition to revive - unintentional | |
| 1501 1,300 | 2501 650 | Utility issue fee (or reissue) | |
| 1502 470 | 2502 235 | Design issue fee | |
| 1503 630 | 2503 315 | Plant issue fee | |
| 1460 130 | 1460 130 | Petitions to the Commissioner | |
| 1807 50 | 1807 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 180 | 1806 180 | Submission of Information Disclosure Stmt | |
| 8021 40 | 8021 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 750 | 2809 375 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 750 | 2810 375 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 1801 750 | 2801 375 | Request for Continued Examination (RCE) | |
| 1802 900 | 1802 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

SUBMITTED BY

(Complete if applicable)

| | | | | |
|-------------------|-----------|-----------------------------------|-----------|--------------|
| Name (Print/Type) | Yi-Qun Li | Registration No. (Attorney/Agent) | Telephone | 925-631-9005 |
| Signature | | | Date | 4/21/04 |

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/01 (08-03)

Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, this information is required to respond to a collection of information unless it contains a valid OMB control number.

**DECLARATION FOR UTILITY OR
DESIGN
PATENT APPLICATION
(37 CFR 1.63)**Declaration
Submitted
With Initial
Filing

OR

Declaration
Submitted after Initial
Filing (surcharge
(37 CFR 1.16 (e))
required)

Attorney Docket Number

First Named Inventor

Yi-Qun Li

COMPLETE IF KNOWN

Application Number

New Patent Application

Filing Date

Herewith

Art Unit

Examiner Name

I hereby declare that:

Each inventor's residence, mailing address, and citizenship are as stated below next to their name.

I believe the inventor(s) named below to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

Magnetic Doped Perovskite Oxides*(Title of the Invention)*

the specification of which



is attached hereto

OR



was filed on (MM/DD/YYYY)

as United States Application Number or PCT International

Application Number

and was amended on (MM/DD/YYYY)

(if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

| Prior Foreign Application Number(s) | Country | Foreign Filing Date (MM/DD/YYYY) | Priority Not Claimed | Certified Copy Attached? | |
|--|---------|-------------------------------------|--------------------------|--------------------------|--------------------------|
| | | | | Yes | No |
| | | | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| | | | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| | | | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| | | | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

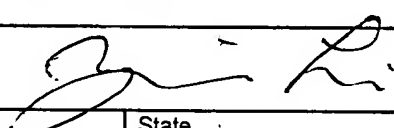
[Page 1 of 6]

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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DECLARATION — Utility or Design Patent Application


| | | | | | |
|---|--|---------------------------|---|---|---------------------------|
| Direct all correspondence to: <input type="checkbox"/> Customer Number: <input type="text"/> | | | | OR <input checked="" type="checkbox"/> Correspondence address below | |
| Name Internatix Corporation | | | | | |
| Address 351 Rheem Blvd | | | | | |
| City Moraga | | | State CA | | ZIP 94556 |
| Country USA | | Telephone 925-631-9005 | | Fax 925-631-7892 | |
| I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon. | | | | | |
| NAME OF SOLE OR FIRST INVENTOR: | | | <input type="checkbox"/> A petition has been filed for this unsigned inventor | | |
| Given Name (first and middle [if any]) Yi-Qun | | | Family Name or Surname Li | | |
| Inventor's Signature  | | | | Date 4/21/04 | |
| Residence: City Walnut Creek | | State CA | | Country USA | Citizenship P. R.China |
| Mailing Address 311 Downham Court | | | | | |
| City Walnut Creek | | State CA | | ZIP 94588 | Country USA |
| NAME OF SECOND INVENTOR: | | | <input type="checkbox"/> A petition has been filed for this unsigned inventor | | |
| Given Name (first and middle [if any]) | | | Family Name or Surname | | |
| Inventor's Signature | | | | Date | |
| Residence: City | | State | | Country | Citizenship |
| Mailing Address | | | | | |
| City | | State | | ZIP | Country |
| <input type="checkbox"/> Additional inventors or a legal representative are being named on the _____ supplemental sheet(s) PTO/SB/02A or 02LR attached hereto. | | | | | |

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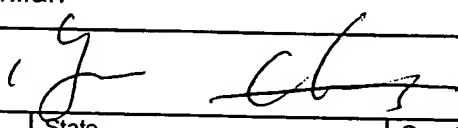
DECLARATION — Utility or Design Patent Application

| | | | | | |
|---|--|---------------------------|---|---|--|
| Direct all correspondence to: <input type="checkbox"/> Customer Number: <input style="width: 100px;" type="text"/> | | | | OR <input checked="" type="checkbox"/> Correspondence address below | |
| Name Internatix Corporation | | | | | |
| Address 351 Rheem Blvd. | | | | | |
| City Moraga | | State CA | | ZIP 94556 | |
| Country USA | | Telephone 925-631-9005 | | Fax 925-631-7892 | |
| I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon. | | | | | |
| NAME OF SOLE OR FIRST INVENTOR: | | | <input type="checkbox"/> A petition has been filed for this unsigned inventor | | |
| Given Name (first and middle [if any]) Ning | | | Family Name or Surname Wang | | |
| Inventor's Signature <i>Ning Wang</i> | | | | Date 4/21/04 | |
| Residence: City Matinez | | State CA | | Country USA | |
| | | | | Citizenship P.R. China | |
| Mailing Address Fiundtainhead Court | | | | | |
| City Martinez | | State CA | | ZIP 94553 | |
| | | | | Country USA | |
| NAME OF SECOND INVENTOR: | | | <input type="checkbox"/> A petition has been filed for this unsigned inventor | | |
| Given Name (first and middle [if any]) | | | Family Name or Surname | | |
| Inventor's Signature | | | | Date | |
| Residence: City | | State | | Country | |
| | | | | Citizenship | |
| Mailing Address | | | | | |
| City | | State | | ZIP | |
| | | | | Country | |
| <input type="checkbox"/> Additional inventors or a legal representative are being named on the _____ supplemental sheet(s) PTO/SB/02A or 02LR attached hereto. | | | | | |

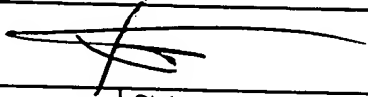
DECLARATION — Utility or Design Patent Application

| | | | |
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| Name Intematix Corporation | | | |
| Address 351 Rheem Blvd. | | | |
| City Moraga, | | State CA | ZIP 94556 |
| Country USA | Telephone 925-631-9005 | Fax 925-631-7892 | |
| I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon. | | | |
| NAME OF SOLE OR FIRST INVENTOR: | | <input type="checkbox"/> A petition has been filed for this unsigned inventor | |
| Given Name (first and middle [if any]) Qizhen | | Family Name or Surname Xue | |
| Inventor's Signature  | | | Date |
| Residence: City Walnut Creek | State CA | Country USA | Citizenship P.R. China |
| Mailing Address 1756 Carmel Dr, #104 | | | |
| City Walnut Creek | State CA | ZIP 94596 | Country USA |
| NAME OF SECOND INVENTOR: | | <input type="checkbox"/> A petition has been filed for this unsigned inventor | |
| Given Name (first and middle [if any]) | | Family Name or Surname | |
| Inventor's Signature | | | Date |
| Residence: City | State | Country | Citizenship |
| Mailing Address | | | |
| City | State | ZIP | Country |
| <input type="checkbox"/> Additional inventors or a legal representative are being named on the supplemental sheet(s) PTO/SB/02A or 02LR attached hereto. | | | |

DECLARATION — Utility or Design Patent Application

| | | | |
|---|------------------------|---|------------------------|
| Direct all correspondence to: <input type="checkbox"/> Customer Number: <input type="text"/> OR <input checked="" type="checkbox"/> Correspondence address below | | | |
| Name Intematix Corporation | | | |
| Address 351 Rheem Blvd. | | | |
| City Moraga | | State CA | ZIP 94556 |
| Country USA | Telephone 925-631-9005 | Fax 925-631-7892 | |
| I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon. | | | |
| NAME OF SOLE OR FIRST INVENTOR: | | <input type="checkbox"/> A petition has been filed for this unsigned inventor | |
| Given Name (first and middle [if any]) Shifan | | Family Name or Surname Cheng | |
| Inventor's Signature  | | Date 4/21/2004 | |
| Residence: City Moraga | State CA | Country USA | Citizenship P.R. China |
| Mailing Address 344 Rheem Blvd #3 | | | |
| City Moraga | State CA | ZIP 94556 | Country USA |
| NAME OF SECOND INVENTOR: | | <input type="checkbox"/> A petition has been filed for this unsigned inventor | |
| Given Name (first and middle [if any]) | | Family Name or Surname | |
| Inventor's Signature | | Date | |
| Residence: City | State | Country | Citizenship |
| Mailing Address | | | |
| City | State | ZIP | Country |
| <input type="checkbox"/> Additional inventors or a legal representative are being named on the _____ supplemental sheet(s) PTO/SB/02A or 02LR attached hereto. | | | |

DECLARATION — Utility or Design Patent Application

| | | | | | |
|---|--|---------------------------|---|---|--|
| Direct all correspondence to: <input type="checkbox"/> Customer Number: <input type="text"/> | | | | OR <input checked="" type="checkbox"/> Correspondence address below | |
| Name Intematix Corporation | | | | | |
| Address 351 Rheem Blvd. | | | | | |
| City Moraga | | State CA | | ZIP 94556 | |
| Country USA | | Telephone 925-631-9005 | | Fax 925-631-7892 | |
| I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon. | | | | | |
| NAME OF SOLE OR FIRST INVENTOR: | | | <input type="checkbox"/> A petition has been filed for this unsigned inventor | | |
| Given Name (first and middle [if any]) Xiao-dong | | | Family Name or Surname Xiang | | |
| Inventor's Signature  | | | | Date | |
| Residence: City Danville | | State CA | | Country USA | |
| Citizenship USA | | | | | |
| Mailing Address 1036 McCouley Rd. | | | | | |
| City Danville | | State CA | | ZIP 94526 | |
| Country USA | | | | | |
| NAME OF SECOND INVENTOR: | | | <input type="checkbox"/> A petition has been filed for this unsigned inventor | | |
| Given Name (first and middle [if any]) | | | Family Name or Surname | | |
| Inventor's Signature | | | | Date | |
| Residence: City | | State | | Country | |
| Citizenship | | | | | |
| Mailing Address | | | | | |
| City | | State | | ZIP | |
| Country | | | | | |
| <input type="checkbox"/> Additional inventors or a legal representative are being named on the _____ supplemental sheet(s) PTO/SB/02A or 02LR attached hereto. | | | | | |



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|--------------------|------------------------|-----------------------|------------------------|
| 10/829,590 | 04/21/2004 | Yi-Qun Li | |

Intematix Corporation
 351 Rheem Blvd.
 Moraga, CA 94556

CONFIRMATION NO. 6712

FORMALITIES LETTER



OC000000013188971

Date Mailed: 07/09/2004

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

Items Required To Avoid Abandonment:

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The statutory basic filing fee is insufficient.
Applicant must submit \$ 10 to complete the basic filing fee for a small entity.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of \$65 for a small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter.

The application is informal since it does not comply with the regulations for the reason(s) indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

- A substitute specification in compliance with 37 CFR 1.52, 1.121(b)(3), and 1.125, is required. The specification, claims, or abstract page(s) submitted is not acceptable and cannot be scanned or properly stored because:
 - The line spacing on the specification, claims, or abstract is not 1½ or double spaced (see 37 CFR 1.52(b)).
- Replacement drawings in compliance with 37 CFR 1.84 and 37 CFR 1.121 are required. The drawings submitted are not acceptable because:
 - The drawings have a line quality that is too light to be reproduced (weight of all lines and letters must be heavy enough to permit adequate reproduction) or text that is illegible (reference characters, sheet numbers, and view numbers must be plain and legible) see 37 CFR 1.84(f) and (p)(1); See Figure(s) 1.

Exhibit B

- An abstract of the technical disclosure not exceeding 150 words in length and commencing on a separate sheet in compliance with 37 CFR 1.72(b) is required. An abstract was not provided for this application.

The applicant needs to satisfy supplemental fees problems indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

- Additional claim fees of \$129 as a small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.

SUMMARY OF FEES DUE:

Total additional fee(s) required for this application is \$204 for a Small Entity

- \$10 Statutory basic filing fee.
- \$65 Late oath or declaration Surcharge.
- Total additional claim fee(s) for this application is \$129
 - \$129 for 3 independent claims over 3.

Replies should be mailed to: Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

*A copy of this notice **MUST** be returned with the reply.*

IRASANTOS

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE



COMBINED DECLARATION AND POWER OF ATTORNEY FOR UTILITY OR DESIGN PATENT APPLICATION

I, a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

MAGNETIC DOPED PEROVSKITE OXIDES

the specification of which (check only one item below):

- ☐ is attached hereto.
- ☒ was filed as United States Patent application Number 10/829,590 on April 21, 2004 and was amended on _____ (if applicable).
- ☐ was filed as PCT International application Number _____ on _____ and was amended on _____ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56.

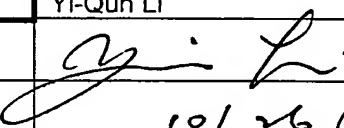
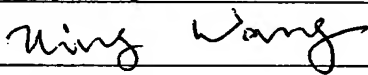
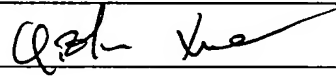
I hereby claim foreign priority benefits under Title 35, United States Code, §§ 119 (a)-(d), 172 or 365(a) of any foreign application(s) for patent or inventor's certificate or of any international (PCT) application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international (PCT) application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:

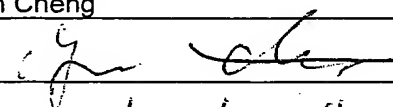
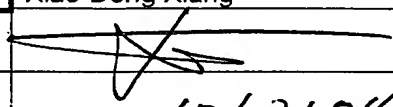
| PRIOR FOREIGN/PCT APPLICATION(S) AND ANY PRIORITY CLAIMS UNDER 35 U.S.C. §§119(a)-(d), 172 or 365(a): | | | | |
|---|--------------------|--------------------------------|---|----|
| COUNTRY (if PCT, indicate "PCT") | APPLICATION NUMBER | DATE OF FILING (MM/DD/YYYY) | PRIORITY CLAIMED UNDER 35 U.S.C. §§119, 172 OR 365(a) | |
| | | | Yes | No |
| | | | | |
| | | | | |
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| | | | | |

I hereby appoint the attorneys and agents associated with the following PTO Customer Number of Burns, Doane, Swecker & Mathis, L.L.P. to prosecute said application and to transact all business in the Patent and Trademark Office connected therewith and to file, prosecute and transact all business in connection with international applications directed to said invention:

Customer Number 2 1 8 3 9

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

| | |
|--|--|
| FULL NAME OF SOLE OR FIRST INVENTOR | Yi-Qun Li |
| Signature |  |
| Date | 10/26/04 |
| Residence (City, State, Country) | Walnut Creek, CA, US |
| Citizenship | CN |
| Mailing Address | 311 Downham Court |
| City, State, ZIP, Country | Walnut Creek, CA, 94588, US |
| FULL NAME SECOND INVENTOR, IF ANY | Ning Wang |
| Signature |  |
| Date | 10/22/04 |
| Residence (City, State, Country) | Martinez, CA, US |
| Citizenship | CN |
| Mailing Address | 47 Fountainhead Court |
| City, State, ZIP, Country | Martinez, CA., 94553, US |
| FULL NAME OF THIRD INVENTOR, IF ANY | Qizhen Xue |
| Signature |  |
| Date | 10/22/2004 |
| Residence (City, State, Country) | Walnut Creek, CA, US |
| Citizenship | CN |
| Mailing Address | 1756 Carmel Drive, #104 |
| City, State, ZIP, Country | Walnut Creek, CA, 94596, US |

| | |
|---|--|
| FULL NAME OF FOURTH INVENTOR, IF ANY | Shifan Cheng |
| Signature |  |
| Date | 10/22/2004 |
| Residence (City, State, Country) | Moraga, CA, US |
| Citizenship | CN |
| Mailing Address | 344 Rheem Blvd., #3 |
| City, State, ZIP, Country | Moraga, CA, 94556, US |
| FULL NAME OF FIFTH INVENTOR, IF ANY | Xiao-Dong Xiang |
| Signature |  |
| Date | 10/21/04 |
| Residence (City, State, Country) | Danville, CA, US |
| Citizenship | US |
| Mailing Address | 1036 McCouley Road. |
| City, State, ZIP, Country | Danville, CA, 94526, US |



LAW OFFICES

BURNS, DOANE, SWECKER & MATHIS, LLP

333 TWIN DOLPHIN DR., SUITE 700
REDWOOD SHORES, CA 94065-1418

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OF

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12731

90-7118-3211

DATE

11-9-04

TO THE ORDER OF

Commissioner of Patents

DOLLARS

DESCRIPTION

034172-017

CHECK
NUMBER

12731

CHECK
AMOUNT

\$ 419.00

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SAN FRANCISCO, CA 94104

The Citigroup Private Bank

BURNS, DOANE, SWECKER & MATHIS, LLP

⑆012731⑆ ⑆321171184⑆ 200001881⑆

Exhibit D



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/829,590 | 04/21/2004 | Yi-Qun Li | 034172-017 | 6712 |
| 7590 07/06/2005 | | | | |
| Internatix Corporation 351 Rheem Blvd. Moraga, CA 94556 | | | | |
| | | EXAMINER | | |
| | | KOSLOW, CAROL M | | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1755 | | |
| DATE MAILED: 07/06/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/829,590

Applicant(s)

LI ET AL.

Examiner

C. Melissa Koslow

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/21/04, 11/9/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1755

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

This application is claiming the benefit of a provisional application under 35 U.S.C. 119(e). However, this application was not filed within twelve months from the filing date of the provisional application, and there is no indication of an intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed within 12 months of the filing date of the provisional application.

Note: If the day that is 12 months after the filing date of the provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the nonprovisional application claiming the benefit of the provisional application may be filed on that next succeeding business day.

The drawings are objected to because the individual graphs should be labeled in figures 1 and 8. It is noted that the specification teaches figure 1 has parts a-d. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be

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labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The disclosure is objected to because of the following informalities: In paragraph [0005],

"(????)" needs either to be deleted or explained. The conjunctions between the elements

defining A, B and M is missing. Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The process of claims 11 and 18 are not found in the specification. Claims 4-9 teach the coercive field is "about" a value and table 1 and paragraphs 25 and 26 teach the coercive field is an exact value. The specification fails to provide antecedent basis for "about". The claimed saturation magnetizations of claims 4-9 are not taught in the specification. The specification teaches residual magnetization. Finally, the specification does not teach the claimed elements of Y, Gd, Ta, W, Nb, Al, Bi, Cr and V.

Claims 1-18 are objected to because of the following informalities: The formulas of claims 1, 4-9, 12, 15, and 16 should be rewritten using subscripts. In claims 1, 2, 10-13, 17 and 18, there is no conjunctions in the claimed lists of elements. In claims 3 and 14, "material" should not be capitalized. In the last line of claims 1 and 12, "and" should not be capitalized. In claims 10 and 17, "s single phase" should be "a single phase" and "sigle" should be "single". In claims 10, 11, 17 and 18, "of" is missing after the phrase "metal oxides". Finally, it is suggested to rewrite step 1 of claims 10 and 17 so it is clear the process is selecting metal oxides in

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amounts to provide the desired stoichiometry of the final perovskite oxide. Appropriate correction is required.

Claims 10, 11, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for producing ferromagnetic perovskite oxides having the formulas $(A_{1-x}M_x)BO_3$ and $A(B_{1-x}M_x)O_3$, where $0 < x < 0.15$ does not reasonably provide enablement for any ferromagnetic perovskite oxide containing the listed metals. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The claims recite processes for making ferromagnetic perovskite oxides. This encompasses any ferromagnetic perovskite containing the metals, such as $Pb(Fe_{2/3}Nb_{1/3})_xTi_yZr_zO_3$, where $x+y+z=1$. However, the specification only teaches the producing oxides having the formulas $(A_{1-x}M_x)BO_3$ and $A(B_{1-x}M_x)O_3$, where $0 < x < 0.15$. Such a limited disclosure does not support the breadth of the instant claims. The examiner suggests the incorporation of these formulas into the respective claims.

Claims 3-11 and 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 17 are duplicate claims. Claims 11 and 18 are duplicate claims. Claims 3, 14 and 15 are improperly depend on claims 1 and 12 respectively. The x range in claims 3 and 14 are broader in scope since they include the end points of 0 and 0.15. If they exclude the end points, then these claims do not further limit claims 1 and 12 respectively, since they are identical to the x value range in the independent claims. The formula in claim 15 is outside that

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of claim 12 since claim 12 teaches the maximum amount of Fe is less than 0.15 and claim 15 teaches the amount of Fe is 0.75. Claims 4-9 recite the limitations "said saturation magnetization" and "the coercive fields". There is insufficient antecedent basis for these limitations in the claims or in claim 1. Claims 15 and 16 recite the limitations "said magnetic Curie temperature" and "the coercive fields". There is insufficient antecedent basis for these limitations in the claims or in claim 12. Claims 11 and 18 are indefinite since the composition of the target is unclear. It is unclear if the target is a mixture of the claimed oxides which will form the perovskite or if it is composed of the perovskite.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,641,940. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed formula in the patent overlaps that claimed in this application.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

~~(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.~~

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chemical Abstract citation 134:140214 for the article by P'rvanova et al.

This abstract teaches perovskite oxide materials having the formula $(1-x)\text{BaTiO}_3 \cdot x\text{NiTiO}_3$, where x is 0.05, 0.1, 0.15. This formula can be rewritten as $\text{Ba}_{1-x}\text{Ni}_x\text{TiO}_3$. The reference clearly teaches the claimed material. Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic, absent any showing to the contrary.

Claim 1 is rejected under 35 U.S.C. 102(a or b) as being clearly anticipated by Chemical Abstract citation 140:311312 for the article by Srivastava et al.

This reference is applicable either under 35 USC 102(a) or (b) depending on the publication month which the Examiner was unable to determine.

This abstract teaches perovskite oxide materials having the formulas $\text{Sr}_{0.9}\text{Fe}_{0.1}\text{TiO}_3$ and $\text{Pb}_{0.9}\text{Fe}_{0.1}\text{TiO}_3$. The reference clearly teaches the claimed material. Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic, absent any showing to the contrary.

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Claim 12 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chemical Abstracts citation 132:312137 for the article by Langhammer et al.

This reference teaches perovskite oxide having the formula $\text{BaTi}_{1-x}\text{Mn}_x\text{O}_3$, where $0 < x \leq 0.05$. The reference clearly teaches the claimed material. Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic, absent any showing to the contrary.

Claims 12-14 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 4-56080.

The abstracts and formulas in the reference teach perovskite oxides having the formula $\text{ATi}_{1-x}\text{M}_x\text{O}_3$, where A is $\text{Ca}_{1-y}\text{Sr}_y$, y is 0-1 and when M is Fe or Co, x is $0 < x \leq 0.05$ and when M is Cr, Mn or Ni, x is $0 < x \leq 0.03$. Page 442 exemplifies $\text{SrTi}_{0.95}\text{Fe}_{0.05}\text{O}_3$. The reference clearly teaches the claimed material. Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic and that $\text{SrTi}_{0.95}\text{Fe}_{0.05}\text{O}_3$ would inherently have the claimed properties, absent any showing to the contrary.

Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 6,641,940.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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This patent exemplifies perovskite oxides having the formulas $\text{Ba}_{0.6}\text{Sr}_{0.4}\text{Ti}_{0.9}\text{V}_{0.1}\text{O}_3$ and $\text{Ba}_{0.6}\text{Sr}_{0.4}\text{Ti}_{0.92}\text{Ta}_{0.07}\text{Cr}_{0.01}\text{O}_3$. The reference clearly teaches the claimed material. Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic, absent any showing to the contrary.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,641,940.

There is evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as U.S. patent 6,641,940 at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. However, this patent additionally qualifies as prior art under another subsection of 35 U.S.C. 102, and therefore, is not disqualified as prior art under 35 U.S.C. 103(c).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

This reference teaches perovskite oxides having the formulas $\text{MTi}_{1-x}\text{V}_x\text{O}_3$, where M is Ba and/or Sr and x is 0.02-0.3. This composition overlaps that claimed. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974);

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In re Fields 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed composition. The reference overlaps the claimed material.

Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic in the overlapping range, absent any showing to the contrary.

~~Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/40058.~~

U.S. patent application publication 2005/0006249 is the English equivalent for WO 03/40058.

This reference teaches producing a perovskite oxide having the formula $(\text{Ln}, \text{A})(\text{Ti}, \text{Fe})\text{O}_3$ where Ln can be La and A is at least one of Ca, Sr and Ba by mixing oxides of Fe, Ti, A and Ln in the desired stoichiometry and firing the mixture at a time and temperature sufficient to form a single phase of the oxide, where the firing atmosphere can be an inactive gas atmosphere (para [0088] and examples). It is notoriously well known that argon gas is an inactive gas that is used as an inactive gas atmosphere. Therefore one of ordinary skill in the art would have found it obvious to use argon as the taught inactive gas atmosphere. The reference suggests the claimed process.

Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,434,742.

This reference teaches forming ferroelectric perovskite oxide thin films by forming a target of the ferroelectric oxide and then depositing a thin film of the ferroelectric oxide by sputtering in an argon atmosphere at 600°C (examples). This reads upon the claimed process.

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The taught ferroelectric perovskite oxide can contain lead, tungsten and iron or cobalt or lead niobium and manganese, iron or nickel (claim 9). The reference suggests the claimed process.

Claims 4-9 and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

There is no teaching or suggestion in the cited art of record of materials having the claimed formulas.

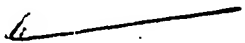
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
July 1, 2005


C. Melissa Koslow
Primary Examiner
Tech. Center 1700

Buchanan Ingersoll PC

Contact: Lori K. Lecker
Director of Communications & Public Relations
1-800-444-6738, ext. 3929
leckerlk@bipc.com

Buchanan Ingersoll Acquires Burns, Doane, Swecker & Mathis: Move Adds 55 IP Lawyers in D.C. Area and California

Washington, D.C., May 25, 2005 -- **Buchanan Ingersoll PC**, one of the largest full-service law firms in the country, announced today that it has acquired **Burns, Doane, Swecker & Mathis, LLP**, a Virginia-based IP firm that has consistently ranked among the top 10 patent firms in the nation in terms of the number of patents granted. The 69-year-old firm has a particularly strong history of patent prosecution and litigation. It also has strong practices in the biotechnology, chemical, electrical, mechanical and nanotechnology industries.

Burns Doane has offices in Alexandria, VA, and San Diego and Redwood Shores, CA. In total, 55 attorneys, 4 patent agents and more than 100 other professionals are joining Buchanan Ingersoll as a result of the acquisition. Some Burns Doane clients include Chevron, Toyota Motor Corp and Deere & Company, maker of John Deere farming equipment.

According to **Thomas L. VanKirk**, Buchanan Ingersoll's CEO, "It's been a busy year for our firm in terms of recruiting new talent, and the lawyers at Burns Doane impressed us with their talent, enthusiasm and strong service to clients around the world. This is a great addition to the firm, and it also allows us to strengthen our West Coast presence."

While this is the largest acquisition Buchanan Ingersoll has made so far this year, it is not the first. In February, the national litigation boutique of Slotnick, Shapiro & Crocker joined the firm in New York. A month later, a group of seven high-profile tax and immigration lawyers in Miami also moved to Buchanan Ingersoll. In April, a group of three government relations professionals were added in the firm's Washington, D.C., office, including former U.S. Congressman Bill Gray. Finally, a pair of IP and business litigation shareholders joined the firm in San Diego last month.

Joe Gess, chair of Burns Doane's Executive Committee, said the firm chose to join Buchanan Ingersoll for a number of reasons, including the culture, teamwork and strategic plan.

- MORE -

Buchanan Ingersoll PC

"We talked to a number of firms, and Buchanan Ingersoll really set itself apart. They understand our practice and showed us right from the beginning how we would fit together. The firm's management approached this process with efficiency and thoroughness, and that made it an obvious choice for us," Gess said.

Following the move, Gess will serve as head of Buchanan Ingersoll's Alexandria office. There will also be a Burns Doane representative on the firm's Board of Directors.

Francis Muracca II, COO of Buchanan Ingersoll, added that the IP and biotech capabilities of the Burns Doane firm supplements Buchanan's national IP, FDA and biomedical practices.

"Their lawyers are truly recognized as pioneers in nanotechnology, and that will help fulfill one of the objectives we set out in our strategic plan: to have a dominant presence in the IP marketplace from coast to coast," he said.

Muracca also confirmed that Buchanan Ingersoll is going to maintain the Burns Doane offices in Redwood Shores, CA, and Alexandria, VA, and transition the name to Buchanan Ingersoll in the coming months. The group in San Diego will join Buchanan Ingersoll's existing office in that city. The firm expects to move into new office space in Del Mar by the end of the summer.

About Burns, Doane, Swecker & Mathis, LLP

Burns, Doane, Swecker & Mathis, LLP, is one of the oldest and largest law firms in the U.S. specializing exclusively in intellectual property, including preparing, filing and prosecuting patent applications in the U.S. and abroad; preparing patentability and infringement opinions; preparing, filing and prosecuting trademark and service mark applications in the U.S. and abroad; preparing licensing agreements; intellectual property litigation; patent interferences; copyrights, and trade secrets. Its Virginia location is just a few blocks from the U.S. Patent & Trademark Office.

Since its founding in 1936, Burns Doane has grown substantially, and has attorneys, patent agents and technical specialists who hold academic degrees in biotechnology; computer and software engineering; electrical; chemical and mechanical engineering; materials science; physics and many other disciplines. Nearly half of those professionals hold master's or doctorate degrees, and many have industry experience or are former examiners at the U.S. Patent and Trademark Office.

- MORE -

Buchanan Ingersoll PC

About Buchanan Ingersoll

Buchanan Ingersoll PC is one of the largest 120 law firms in the nation. Following the acquisition of Burns Doane, the firm has more than 390 attorneys and government relations professionals practicing throughout the United States, with principal offices in the cities of Washington, D.C., Alexandria, New York, Philadelphia, Pittsburgh, Princeton, Harrisburg, Miami, Tampa, Wilmington, Cleveland, Redwood Shores and San Diego.

The firm's attorneys have experience in a range of industries such as entertainment and media, pharmaceuticals and biomedicine, technology, financial institutions, construction, franchise and real estate. Within these and other industries, Buchanan Ingersoll attorneys focus on more than 65 different practice areas including Corporate Finance, Litigation, Tax, Government Relations and Health Care. The firm serves national and international clients that include Fortune 500 corporations, start-ups, technology companies and financial institutions.

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/829,590 | 04/21/2004 | Yi-Qun Li | 034172-017 | 6712 |

7590 02/13/2006
Internatix Corporation
351 Rheem Blvd.
Moraga, CA 94556

EXAMINER

KOSLOW, CAROL M

ART UNIT PAPER NUMBER

1755

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of Abandonment

Application No.

10/829,590

Examiner

C. Melissa Koslow

Applicant(s)

LI ET AL.

Art Unit

1755

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address—

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 06 July 2005.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85):
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$ _____ is insufficient. A balance of \$ _____ is due.
The issue fee required by 37 CFR 1.18 is \$ _____. The publication fee, if required by 37 CFR 1.18(d), is \$ _____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37):
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

C. Melissa Koslow
Primary Examiner
Art Unit: 1755

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Chaffin-Penny, Krista

From: Chaffin-Penny, Krista
Sent: Wednesday, April 12, 2006 10:57 AM
To: Hawkins, Debra
Cc: Dufault, Sherrie
Subject: Our Reference No. 1034172-000017

Hi Debbie,

I need to get a copy of the postcard stamped by the PTO for the Response to Missing Parts filed November 9, 2004. The Patent Office doesn't show any record of our filing a Power of Attorney; therefore the address was never changed to ~~BDSM. An Office Action was mailed to the client's old address which was not forwarded to the new address, which then~~ of course means that it was never responded to because no one knew it existed. I just call the Patent Office to check on the status of the application and found out it went abandoned in February. I need to file a Letter Requesting Withdrawal of Holding of Abandonment including a copy of the postcard stamped by the PTO showing that they did receive the Power on November 9, 2004.

Thanks,

Krista

Exhibit H

4/12/2006